

REMARKS

Claims 1-6, 8-11, 15, 16, 18, 19, 21-52, 54-56, 58-71, 77-82, 84-86, 88-106, 108-115, 117 and 118 are pending in the application, with claims 1, 47, 77, and 98 being independent.

RESTRICTION REQUIREMENT

The Examiner has required restriction to one of the following inventions under 35 U.S.C.

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- I. Claims 1-6, 8-11, 15, 16, 18, 19 and 21, drawn to an aqueous composition, classified in class 524, subclass 800;
- II. Claims 22, 23 and 40, drawn to an aqueous composition further comprising a fluoacid, classified in class 525, subclass 514;
- III. Claims 24-31 and 41-44, drawn to substrates coated with an aqueous composition, classified in class 428, subclass 423.1;
- IV. Claims 32-35, 46, 64-69, 95-97, 114, 115, 117 and 118, drawn to products or articles comprising cured compositions, classified in class 428, subclass 425.1
- V. Claims 47-52, 54-56, 58-63, 70, 71, 77-82, 84-86, 88-94, 98-106, and 108-113, drawn to a method of preparing a coated substrate, classified in class 427, subclass 207.1.

In an attempt to justify the requirement for restriction, the Examiner has taken the position that inventions I and II are related as combination and subcombination; that inventions I or II and III or IV are related as product and process of use; and that inventions IV and V are related as process of making and product made. The Examiner states that the inventions are independent or distinct, and that restriction is proper.

Election

In order to be responsive to the requirement for restriction, Applicants elect the invention set forth in Group I, claims 1-6, 8-11, 15, 16, 18, 19 and 21, with traverse.

Traverse

Notwithstanding the election of the claims of Group I (made in order to be responsive to the Restriction Requirement), in order to preserve the right to petition for withdrawal of the Restriction Requirement, Applicants respectfully traverse the requirement for restriction.

It is respectfully submitted that the restriction requirement is improper for not being timely made, and is without appropriate basis at least because it mischaracterizes the Groups asserted to be related as product and process of use.

The restriction requirement is improper because it is not timely made

The present restriction requirement was made on May 5, 2006, ***nearly six years after the application was filed***. During this time, the Examiner has conducted searches of the prior art, and has considered documents submitted in Information Disclosure Statements. Indeed, this application had been subjected to a restriction requirement on September 7, 2001, and the non-elected claims were re-joined when the elected claims were allowed on July 19, 2004. The application did not issue at that point because an RCE was filed in order to submit an Information Disclosure Statement. In the RCE, the Examiner chose not to re-impose the restriction requirement, and instead issued a non-final rejection (on July 18, 2004)

and a final rejection (on December 20, 2005). In this regard, the Examiner's attention is drawn to the Code of Federal Regulations, which states that a restriction requirement:

will normally be made before any action on the merits; however, it may be made at any time **before final action**.

37 CFR § 1.142 (a) (emphasis added). In this case, a final office action issued on December 20, 2005. Even though finality of the office action was withdrawn, this does not change the fact that the current restriction requirement was made, in contravention with regulation, only after a final office action, and after nearly six years from filing.

For at least this reason, it is respectfully requested that the restriction requirement be withdrawn.

The restriction requirement is improper because the Examiner has not established a serious burden

Mere presence of different claimed inventions is not sufficient to warrant restriction or election. As stated in the MPEP,

If the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it contains claims to independent or distinct inventions.

MPEP § 803 (emphasis added). However, if a restriction or election is imposed after the first office action on the merits, then the Examiner should make a yet additional showing. In particular, the MPEP states:

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

MPEP § 811.

In this case, the Examiner improperly waited until after a final rejection to impose a restriction requirement, and in that restriction requirement improperly did not establish the higher requirement that there be a serious burden if restriction is not required.

It is respectfully submitted that the Examiner cannot establish a serious burden in this case, because there would be no serious burden if restriction is not required. The Examiner has already conducted searches for the claims, and has already examined the claims. Moreover, the Examiner who imposed a pre-RCE restriction requirement is the very same Examiner who chose not to impose a restriction requirement before the non-final or final rejections after filing the RCE. That the Examiner examined the claims, and issued non-final and final rejections of the claims, demonstrates that there is no serious burden imposed by examining the claims together. Further, that the same Examiner who had previously imposed a restriction requirement chose not to re-impose a restriction requirement after the RCE was filed is additional evidence that the Examiner (at least until after issuing the final rejection) did not consider examining all the claims to be a serious burden.

In any event, the search for the two groups of invention appears to be at least related, and should certainly overlap if not actually be coextensive. Thus, there would be no serious burden on the Examiner to examine all of the claims in this application. For this reason, and consistent with Office policy set forth in MPEP 803, Applicants respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

The restriction requirement is defective because it incorrectly characterizes several groups of claims

In an attempt to justify restriction, the Restriction Requirement states that “[i]nventions I or II and III or IV are related as product and process of use.” In fact, all of the claims referred to are product claims. None are process of use claims. Accordingly, the basis for restriction of these groups of claims is without sufficient basis.

Thus, for this additional reason, the Restriction Requirement is without sufficient basis, and should be withdrawn.

Conclusion

In view of the foregoing, it is respectfully requested that the Examiner reconsider the requirement for restriction and election of species, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.

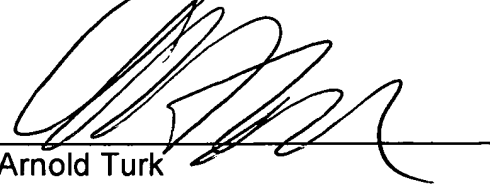
CONCLUSION

For the reasons discussed above, it is respectfully submitted that the Examiner's requirement for restriction is improper and should be withdrawn. Accordingly, withdrawal of the requirement for the restriction with the examination of all claims pending in this application is respectfully requested.

In order to advance prosecution of this application (which has been pending nearly six years), Applicants respectfully request that the Examiner also reconsider and withdraw the rejections of record, and allow all pending claims.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed telephone number.

Respectfully submitted,
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